

REMARKS

In the office action mailed February 10, 2005, claims 1-42 were pending for consideration. The Examiner has indicated that claims 11, 12, and 15 are allowable if rewritten in independent form. Claims 1-10, 13-14, and 16-42 were rejected under 35 U.S.C. 102(e) and 103(a) in light of Kirkor (U.S. Patent Publication 2004/0262582) in various combinations of two additional references. Applicant appreciates the indication of allowable subject matter. Claim 3 was also rejected under 35 USC 112, first paragraph. Each of the Examiner's rejections are addressed in turn below.

Rejections under 35 U.S.C 102(e)

The Examiner has rejected Claims 1, 2, 4-10, 13-14, 16-35, 37-38, and 41-43 under 102(e) as anticipated by Kirkor in view of Filas (U.S. Patent No. 6,741,019), the latter of which was cited as a teaching reference only. The Applicant has submitted herewith an affidavit under 37 C.F.R. 1.131 in order to swear behind the filing date of Kirkor. Specifically, Kirkor was filed on June 30, 2003 and the inventors have signed the declaration to the effect that the invention was conceived and reduced to practice prior to June 30, 2003. The declaration is submitted to overcome the rejections of the above claims and should not be construed to affect any claims already considered allowable. As Kirkor is no longer available as a reference, the rejections based on Kirkor should be withdrawn.

Rejections under 35 U.S.C. 103(a)

The Examiner has also rejected Claims 27, 33, 34, 36, 39, and 40 under 35 U.S.C. 103(a) over Kirkor further in view of Kirkow. The Applicant is unaware of any reference cited having an inventor named Kirkow. Regardless, the above mentioned declaration under 37 C.F.R. 1.131 has been submitted to remove Kirkor as a reference.

Therefore, this rejection should be withdrawn and a notice of allowance of the claims would be appreciated.

Rejection under 35 U.S.C. 112, first paragraph

The Examiner has also rejected Claim 3 as failing to comply with the enablement requirement. Specifically, the Examiner asserts that “nanobelts, nanoplates, or nanodiscs” are not enabled because the examples only disclose ZnO nanowires. Applicant respectfully submits that the Examiner is incorrect. Nanobelts, nanoplates and nanodiscs are relatively well known structures and are readily available from commercial sources or manufactured using published resources or methods such as those explicitly listed in the specification.

With respect to enablement of the present claims, the considerations for formation of ink-jet compositions containing nanowires is substantially the same as for formulations including nanobelts, nanoplates, and nanodiscs. Thus, those skilled in the art will have no difficulty in substituting such structures for the specifically exemplified structures. Further, the specification provides guidelines which are equally applicable to nanowires as to other structures. For example, page 7, line 21 through page 8, line 27 describes parameters with respect to the nanostructures which are considered to enable those skilled in the art to formulate suitable ink-jet compositions.

Further, there is no requirement that the Applicant specifically exemplify each and every species of a claimed invention. Applicant submits that the direction provided in the specification and the Examples are sufficiently explicit to enable a person skilled in the art to formulate ink-jet ink compositions having any of the recited nanostructures.

Therefore, Applicant respectfully submits that this rejection is inappropriate and should be withdrawn.

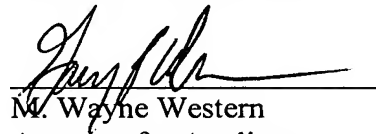
Conclusion

In view of the foregoing, Applicant respectfully requests that claims 1-10, 13-14, and 16-42 also be allowed since the primary reference relied upon by the Examiner has been removed via a declaration under 37 C.F.R. 1.131. If any impediment to the allowance of these claims remains after consideration of the above remarks, and such impediment could be resolved during a telephone interview, the Examiner is invited to telephone Susan Heminger at (650) 236-2738 so that such issues may be resolved as expeditiously as possible.

Please charge any additional fees except for Issue Fee or credit any overpayment to Deposit Account No. 08-2025.

Dated this 6 day of June, 2005.

Respectfully submitted,



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